

S/N 09/712,064

Response to Office Action Dated 12/06/2004

REMARKS

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. This amendment is believed to be fully responsive to all issues raised in the 12/06/2004 Office Action.

Claims Amendments

Claims 1—15, 31—45 and 61—75 are original and 91—109 were previously presented.

The §103 Rejections

The Applicant submits that the Office has failed to establish a *prima facie* case of obviousness and, in view of the comments below, respectfully traverses the Office's rejections. However, before discussing the substance of the Office's rejections, a section entitled "The §103 Standard" is provided and will be used in addressing the Office's rejections. Following this section, sections entitled "The Kim Reference" and "The How-To Reference" are provided, which describe the disclosure and teachings of these two references.

A new section, "The Technology of How-To Cannot be Adapted for Use in a Browser" is very important; accordingly, the Applicant requests that the Examiner read this section carefully.

The §103 Standard

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. MPEP § 2142. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375
2 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined)
3 must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180
4 USPQ 580 (CCPA 1974).

5 Hence, when patentability turns on the question of obviousness, the search
6 for and analysis of the prior art includes evidence relevant to the finding of
7 whether there is a teaching, motivation, or suggestion to select and combine or
8 modify the references relied on as evidence of obviousness. The need for
9 specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371,
10 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to
11 the reason the skilled artisan, with no knowledge of the claimed invention, would
12 have selected these components for combination in the manner claimed").

13 The Kim Reference

14 The Kim Reference teaches a browser adapted to put advertisements onto
15 the screen. In particular, Kim teaches an application which runs as part of, or in
16 conjunction with, a browser program. The application periodically downloads
17 advertisements (ads) when the browser is substantially idle and stores them locally
18 (Abstract; lines 4—7). Kim detects transition from a first web page to a second
19 web page, and takes advantage of the time during which it takes the second
20 webpage to download (0045; lines 1—2) to display (0077; lines 5—10) the locally
21 stored ads. Note that the ad may occupy the full window of the browser (0078;
22 lines 2—5), a partial window, or may be positioned outside the window (0078;
23 lines 10—13).

24 Therefore, Kim teaches browser technology configured *for the display of*
25 *ads*, either in the full browser window, a part of the browser window or in a new

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 window. The ads are displayed in response to a change from the first webpage to
2 the second webpage. However—as the Office Action points out and the Applicant
3 agrees—Kim does not disclose ignoring requests for a second window where the
4 request was not initiated in response to user action.

5 Kim mentions pop-up ads in four paragraphs. In 0009, Kim mentions that
6 pop-up ads may result in “consumers (becoming) upset and bothered.” The
7 context for this statement is that pop-up ads are not a beneficial method for
8 advertising and that advertisers should advertise according to the methods of Kim.
9 The context of this statement is not that Kim is considering ways to fight pop-up
10 ads. Kim is only saying that Kim’s way of advertising is a better way of
11 advertising. In 0038, Kim again indicates that pop-up ads are not an effective
12 advertising tool. In 0123 Kim mentions that pop-up ads can block the user’s view,
13 and in 0145, Kim mentions the interference pop-up ads can cause. However,
14 nothing in Kim suggests that Kim is considering “fighting” pop-up ads; only that
15 Kim considers them to be an inferior method of advertising. Kim is in fact very
16 pro-advertising, having disclosed a system and method for advertising.
17 Accordingly, nothing in Kim suggests that Kim is considering the addition of an
18 apparatus or method of stopping pop-up ads.

19 The “How-To” Reference

20 In contrast to the browser software seen in Kim, the How-To reference
21 teaches *changing the code that comprises a website* to prevent the host of the
22 website from inserting successful pop-up ads into responses sent by the website to
23 hits made on the website.

24 In particular, the How-To reference discloses a number of strategies by
25 which a website owner can change a website to prevent display of advertisements

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 that the host server of the website inserts. Accordingly, the How-To reference
2 does not disclose browser technology that ignores or follows instructions for
3 opening a second window. Instead, How-To discloses website modifications.

4 In general, the background and teachings of How-To may be understood by
5 the following exemplary scenario:

- 6 1. A Website Admin writes code to configure a Website.
- 7 2. The Website Admin hires Host (an internet service provider (ISP))
8 to physically host the Website.
- 9 3. Website Admin notices that Host is injecting Host's pop-up ads into
10 the responses to "hits" on Admin's website. Website Admin is
11 upset, since Website viewers may avoid Website due to Host's
12 advertising.
- 13 4. Website Admin investigates and realizes that Host is employing any
14 of several methods to introduce the ads. Accordingly, Website
15 Admin must find out (1) what the Host is doing to introduce the pop-
16 up ads, and (2) consult How-To for indicated remedy. For example
17 to kill pop-up as they appear, Admin must check to see what Host
18 has named the window (How-To, middle of page 3 of 6).
- 19 5. Website Admin alters the code in Website (according to How-To's
20 instructions) to nullify Host's strategy of introducing pop-up ads into
21 Website Admin's Website.

22 Thus, we realize that How-To is adapted for use on a website to thwart ads
23 injected by the website's host. How-To instructs that the host may employ any of
24 many strategies to insert pop-up ads—accordingly, How-To provides six pages of
25 possible solutions. *None of the solutions always works. The administrator of the*

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 *website must find the solution that works in view of what the host is doing. The*
2 *administrator must then change the code of the website.*

3 While How-To's technology works well for website owners, it does not
4 combine with browser technology in a successful manner.

5 **The Technology of How-To Cannot be Adapted for Use in a Browser**

6 As seen above, to justify the combination of two references in making a
7 section 103 rejection, there must be a reasonable expectation of success. *In re*
8 *Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, it
9 is very doubtful that the technologies can be combined. A number of factors
10 prevent application of How-To's technology to browsers. They include at least
11 the following:

12 1. How-To provides ten or more strategies for thwarting ads, and assumes
13 that a website owner can figure out which strategy is appropriate for the website in
14 question. No automated method of quickly figuring out what strategy should be
15 applied to any given website is disclosed. How-To implies that the website owner
16 will have to investigate and do some trial and error work to determine what the
17 host is doing to insert ads, and then select an appropriate fix from How-To's
18 technology. However, for How-To's technology to be effectively used in a
19 browser, a way must be provided to enable the browser to instantly know which of
20 How-To's fixes to apply, or the ad will slip through. Thus, while How-To works
21 fine for the website owner who can patiently figure out which of How-To's fixes
22 to apply, How-To's technology is not adapted for use with a browser, since How-
23 To provides no automated mechanism which explains which fix should be applied
24 by the browser when receiving information from any given website.
25

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 2. Several of How-To's strategies involve "commenting out" parts of the
2 code sent to the browser. That is, statements intended to create ads are turned into
3 ineffective "comments" by the changes made to the code by the How-To
4 teachings. This assumes knowledge of the website's code, and the ability to
5 distinguish the website's code from code associated with advertisements. The
6 website owner has this knowledge, and is in a position to distinguish the ad-related
7 code. The browser has no way of distinguishing website code from ad code. The
8 website owner is familiar with the website code, and is able to insert the
9 <noscript> or <!--(comment) tags suggested by How-To (How-To, page 1) in the
10 correct locations. However, How-To is silent about how a browser could possibly
11 know where to insert the comment tags. For example, the website may have a
12 "good" window and a pop-up ad window, and the browser (not having the
13 information available to How-To's audience of website owners) would not know
14 which was which. Thus, while a website owner would know which window to
15 comment out, the browser could not possibly know. Thus, while How-To's
16 technology works fine for the website owner, it would not work for a browser.

17 3. Several of How-To's fixes involve learning the name of pop-up ad
18 windows, and then using that information to thwart opening of the pop-up ad
19 window. Learning the window name is possible for the website owner, who can
20 experiment some, and learn the name(s) of windows that are not part of the
21 website (and are therefore ads). However, How-To provides no information on
22 how a browser could determine—between two window names within the code
23 sent by the website—which was the pop-up ad window and which window was
24 part of the website. Thus, while the owner of the website would know the name of
25 the website's windows (and thus be able to distinguish the names of the ad

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 windows) the browser could not possibly have this information. Thus, while
2 How-To's technology works fine for the website owner, it would not work for a
3 browser.

4 4. Several of How-To's techniques require some knowledge of the
5 website's code in order to know if a given fix can be safely used. For example,
6 according to one of How-To strategies, pop-up ads may be killed by turning off
7 JavaScript. However, this is only applicable where the website itself does not use
8 JavaScript. How-To—whose audience includes website owners—assumes that
9 this is an easy question, i.e. 'Can JavaScript be turned off without impacting the
10 website?' However, How-To does not make it clear how a browser—which may
11 be downloading code for the first time from a website—could answer such a
12 question. Thus, while How-To's technology works fine for the website owner, it
13 would not work for a browser.

14 Because of these reasons and others, unresolved technical difficulties
15 prevent How-To from being combined with Kim or any other browser technology.

16 **Traversal of the §103 Rejections**

17 Claims 1—15, 31—45 and 61—75 are 91—109 were rejected under 35
18 U.S.C. section 103(a) as being anticipated by U.S. application 2002/0052925
19 ("Kim") and the How-To document (How-To). The Applicant respectfully
20 traverses the rejection of claims 1—15, 31—45 and 61—75 are 91—109.

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 **Claim 1** recites a computer system having a graphical user interface
2 including a display and a user interface selection device, a method of maintaining
3 a single window interface, comprising:

- 4 • receiving a request to open a second browser window while a first
5 browser window is displayed;
- 6 • **ignoring the request if the request was not initiated in response**
7 **to a user action;** and
- 8 • opening the second browser window if the request was initiated in
9 response to a user action.

10 **Claims 31, 61, and 91** include similar recitations.

11 The How-To reference teaches how website software can be modified, so
12 that upon receipt by a browser, ads are not displayed. However, the How-To
13 reference cannot be combined with the technology of a browser within any
14 realistic expectation of success. Accordingly, the combination of Kim and How-
15 To is improper, and the associated rejections should be withdrawn. The section
16 "The Technology of How-To Cannot be Adapted for Use in a Browser" (above) is
17 incorporated herein.

18 Technical difficulties prevent How-To from being combined with Kim or
19 any other browser technology. Application of How-To's website-based
20 technology to a browser results in a number of unresolved technical questions.
21 For example, 'how should the browser choose from among How-To's strategies,
22 when How-To fails to provide an algorithm by which a correct strategy can be
23 immediately selected?' How-To fails to disclose how someone without access to a
24 "clean" version of the website code (i.e. website code unpolluted by ads) can
25 know which part of the code downloaded from the website can safely be

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 commented out. How-To fails to disclose how someone without access to a
2 "clean" version of the website code can know which window names are those of
3 valid website windows, and which window names are those of ads. How-To fails
4 to disclose how someone without access to a "clean" version of the website code
5 can know whether it is safe to apply some of How-To's tricks, such as disabling
6 JavaScript. Therefore, the combination of Kim's technology with How-To's
7 technology has little expectation of success.

8 Thus, while How-To capably discloses how a website owner can block ads,
9 How-To fails to address the subject of how a browser can block ads. In fact, a
10 number of unresolved technical issues indicate that combination of the How-To
11 reference with Kim should not be expected to result in success. Accordingly, the
12 combination of How-To and Kim is improper.

13 The Patent Office suggests that since How-To teaches blocking ads that
14 were not requested, that How-To's technology could be combined with the
15 browser of Kim to yield a combined technology disclosing the recited claim.
16 However, as we have seen above, the combination of How-To and Kim would
17 raise substantial unresolved technical issues, and would be inoperative. This is
18 because How-To is addressing an issue that is sufficiently different from browser
19 technology. One or more of How-To's solutions may be applicable to removing
20 ads from one known website, wherein the "clean" code (unpolluted by ads) is
21 known. However, How-To does not resolve technical issues raised by the need to
22 remove ads from any arbitrary website to which a browser visits.

23 Therefore, Kim, adapted with How-To's technology, would be non-
24 functional, and the combination of Kim and How-To is improper. Accordingly,
25

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 the Applicant respectfully requests that the rejection of claims 1, 31, 61 and 91 be
2 removed.

3 **Claim 9** recites a computer system having a graphical user interface
4 including a display and a user interface selection device, a method of maintaining
5 a single window interface, wherein the method further comprises:

- 6 • suppressing a request to open a dialog box until a browser window
7 associated with the request to open the dialog box is displayed.
8

9 **Claims 39, 69, and 99** include similar recitations.

10 The cited portions of the Kim reference fail to disclose the use of a dialog
11 box generally, or suppressing a request to open a dialog box particularly.
12 Accordingly, the rejection is improper, and the Applicant respectfully requests that
13 the rejection be removed from claims 11, 41, 71 and 101.

14 **Claim 11** recites a computer system having a graphical user interface
15 including a display and a user interface selection device, a method of maintaining
16 a single window interface, wherein the method further comprises:

- 17 • receiving a request to close a browser window;
18 • closing the browser window if another browser window is open; and
19 • ignoring the request if no other browser window is open.
20

21 **Claims 41, 71, and 101** include similar recitations.

22 The cited portions of the Kim reference refer to detecting whether a
23 webpage downloading time, which if exceeded, results presentation of an ad. After
24 the ad is displayed for a contracted time, the ad is removed and the downloading
25 page is displayed. This does not disclose "receiving a request to close a browser

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 window," since no request is disclosed. It also does not disclose "ignoring the
2 request if no other browser window is open," since no ignoring is disclosed.
3 Accordingly, the rejection is improper, and the Applicant respectfully requests that
4 the rejection be removed from claims 11, 41, 71 and 101.

5 **Claim 12** recites a computer system having a graphical user interface
6 including a display and a user interface selection device, a method of maintaining
7 a single window interface, wherein the method further comprises:

- 8 • maintaining, in a browser history, a history of transitions between
9 the first and second browser windows.

10
11 **Claims 42, 72, and 102** include similar recitations.

12 The cited portions of the Kim reference refer to archiving *information*
13 *content* (Kim, paragraph 0049). This is not the same as "maintaining a browser
14 history," i.e., the list that instructs the browser which page to go to when the back
15 and forward browser buttons are pressed. Accordingly, the rejection is improper,
16 and the Applicant respectfully requests that the rejection be removed from claims
17 12, 42, 72 and 102.

18 **Claim 13** recites a computer system having a graphical user interface
19 including a display and a user interface selection device, a method of maintaining
20 a single window interface, wherein the method further comprises:

- 21 • building the browser history from a history of a displayed browser
22 window.

23
24 **Claims 43, 73, and 103** include similar recitations.

S/N 09/712,064

Response to Office Action Dated 12/06/2004

1 The cited portions of the Kim reference refer to archiving *information*
2 *content* (Kim, paragraph 0049). This is not the same as "building a browser
3 history from a history of a displayed browser window." Accordingly, the rejection
4 is improper, and the Applicant respectfully requests that the rejection be removed
5 from claims 12, 43, 73 and 103.

6 **Claims 2—15, 32—45, 62—75 and 92—105**

7 These claims are allowable due to their dependency on claims that are
8 allowable for the reasons seen above, as well as for reasons associated with the
9 elements recited in each claim.

10 **Claims 106—109**

11 Claims 106—109 are allowable as being dependent on claims allowable for
12 the reasons seen above, as well as for reasons associated with the elements recited
13 in each claim. In particular, claims 106—109 recite an example of how "in
14 response to user action" and "not in response to user action" can be determined.
15 Neither Kim nor How-To evaluate "if the request" was or was not initiated "in
16 response to a user action." Accordingly, neither Kim nor How-To disclose the
17 elements recited in claims 106—109, which are allowable for at least this reason.

18 **Non-Rejected Claims**

19 Claims 107-109 are not specifically rejected. Numerous cancelled claims
20 are rejected in other sections. Additionally, the claim numbers recited in the
21 rejection beginning second line from the bottom page 6, and also at the middle of
22 page 8, are confusing.

S/N 09/712,064

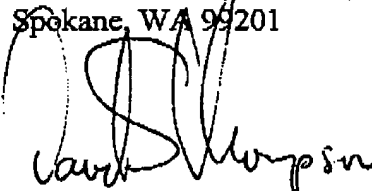
Response to Office Action Dated 12/06/2004

Conclusion

The technology of the How-To is not adapted for combination with the Kim reference. While How-To may disclose technology that is well adapted to modify websites in a manner that thwarts ads, How-To fails to disclose how this technology could be adapted for use in browsers. Therefore, a combination of Kim's technology and How-To's technology would be non-functional, in part due to large and unresolved technical issues. Accordingly, the combination of Kim and How-To is improper. Therefore, the Applicant respectfully requests that the rejection to claims 1—15, 31—45, 61—75 and 91—109 be removed. Should any issue remain that prevents immediate issuance of the application, the Examiner is encouraged to contact the undersigned attorney to discuss the unresolved issue.

Respectfully Submitted,
Lee & Hayes, PLLC
421 W. Riverside Avenue, Suite 500
Spokane, WA 99201

Dated: 4-6-05


David S. Thompson
Reg. No. 37,954
(509) 324-9256 ext. 235